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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/683,239

12/05/2001

Gregory T. Grefenstette

D/A1320Q

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09/22/2005

PATENT DOCUMENTATION CENTER

XEROX CORPORATION

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ROCHESTER, NY 14644

EXAMINER

CAMPBELL, JOSHUA D

ART UNIT

PAPER NUMBER

2178

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/683,239

Applicant(s)

GREFENSTETTE ET AL.

Examiner

Joshua D. Campbell

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2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

PD

### DETAILED ACTION

1. This action is responsive to communications: Amendment filed on 07/07/2005.
2. Claims 1-20 are pending in the case. Claims 1, 9, and 12 are independent claims. Claims 1, 5, and 9-14 have been amended. Claims 15-20 have been added.

### ***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-7 and 9-<sup>20</sup>~~18~~ are rejected under 35 U.S.C. 103(a) as being unpatentable over Horowitz et al. (hereinafter Horowitz, US Patent Number 6,122,647, issued on September 19, 2000) in view of Goodisman et al. (hereinafter Goodisman, US Patent Application Publication Number 2002/0069223, US filing date of November 17, 2000).

WJ 9/17/05

**Regarding independent claim 1**, Horowitz discloses a method in which a document identifier, which identifies electronic document content, is recorded with a reading device (column 5, lines 56-64 and column 9, lines 1-63 of Horowitz). The document identifier is associated with a personality identifier at the reading device and both identifiers are transmitted to a server (column 9, lines 1-63, column 10, lines 8-27, and column 11, lines 24-52 of Horowitz). The electronic document content, defined by the document identifier, is then enriched based on the personality (theme) identified by the personality identifier, wherein enrichment includes recognizing and annotation entities in the electronic document based on the personality (theme) defined by the

identifier (column 9, lines 1-63, column 10, lines 8-27, and column 11, lines 24-52 of Horowitz). Horowitz does not disclose a method in which the personality identifier identifies a personality with a reading device. However, Goodisman discloses a method in which the reading device automatically defines a personality that is associated with a personality identifier (page 1, paragraphs 0006-0007 and page 2, paragraphs 0025-0026 of Goodisman). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Horowitz and Goodisman because it would have allowed for increased mobility when enriching documents.

**Regarding dependent claims 2-4,** Horowitz discloses a method in which the document identifier is encoded into the hardcopy of the document as an electronic tag which is recorded by an electronic tag-reading device (column 9, lines 9-63 of Horowitz).

**Regarding dependent claim 5,** Horowitz discloses a method in which a personality identifier is associated with identified document content (Figure 8 and column 10, lines 4-45 of Horowitz). An entity in the document content is recognized and a document service is accessed using the recognized entity (column 8, lines 39-61 and column 9, lines 28-63 of Horowitz). The identified document content is then annotated with output from the document service to define enriched content, at which point the content is made available to the users (column 10, lines 4-45 and column 11, lines 39-52 of Horowitz).

**Regarding dependent claims 6 and 7,** Horowitz does not disclose a method in which the reading device is mobile or position dependent. However, Goodisman discloses a method in which the reading device can be mobile and position dependent (page 1, paragraphs 0006-0007 and page 2, paragraphs 0025-0026 of Goodisman). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Horowitz and Goodisman because it would have allowed for increased mobility when enriching documents.

**Regarding independent claim 9,** Horowitz discloses a method in which a document identifier, which identifies electronic document content, or the document content is recorded with a reading device (column 5, lines 56-64 and column 9, lines 1-63 of Horowitz). The document identifier or document content is associated with a personality identifier at the reading device and both identifiers or the identifier and the document are transmitted to a server (column 9, lines 1-63, column 10, lines 8-27, and column 11, lines 24-52 of Horowitz). The electronic document content, defined by the document identifier, is then enriched based on the personality (theme) identified by the personality identifier, wherein enrichment includes recognizing and annotation entities in the electronic document based on the personality (theme) defined by the identifier (column 9, lines 1-63, column 10, lines 8-27, and column 11, lines 24-52 of Horowitz). Horowitz does not disclose a method in which the personality identifier identifies a personality with a mobile device or that position coordinates are identified and used to look up a personality identifier. However, Goodisman discloses a method in which a mobile computing device automatically identifies a personality and the location of the

device at the time (position coordinates), which is used to find specific document content (document identifier), based on the personality identifier of the device when it is detected, that would be appropriate for the users current location (page 1, paragraphs 0006-0007 and page 2, paragraphs 0025-0026 of Goodisman). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Horowitz and Goodisman because it would have allowed for increased mobility when enriching documents.

**Regarding dependent claim 10**, Horowitz does not disclose a method in which the look up is further refined using a time at which the document or document identifier is selected. However, Goodisman discloses a method in which a time is used to further refine the lookup process (page 2, paragraphs 0025-0026 of Goodisman). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Horowitz and Goodisman because it would have allowed for increased mobility when enriching documents.

**Regarding dependent claim 11**, Horowitz discloses a method in which a personality identifier is associated with identified document content (Figure 8 and column 10, lines 4-45 of Horowitz). An entity in the document content is recognized and a document service is accessed using the recognized entity (column 8, lines 39-61 and column 9, lines 28-63 of Horowitz). The identified document content is then annotated with output from the document service to define enriched content, at which point the content is made available to the users (column 10, lines 4-45 and column 11, lines 39-52 of Horowitz).

**Regarding independent claim 12**, Horowitz discloses a method in which a document identifier, which identifies electronic document content, or the document content is recorded with a reading device (column 5, lines 56-64 and column 9, lines 1-63 of Horowitz). The document identifier or document content is associated with a personality identifier at the reading device and both identifiers or the identifier and the document are transmitted to a server (column 9, lines 1-63, column 10, lines 8-27, and column 11, lines 24-52 of Horowitz). The electronic document content, defined by the document identifier, is then enriched based on the personality (theme) identified by the personality identifier, wherein enrichment includes recognizing and annotation entities in the electronic document based on the personality (theme) defined by the identifier (column 9, lines 1-63, column 10, lines 8-27, and column 11, lines 24-52 of Horowitz). Horowitz does not disclose a method in which the personality identifier identifies a personality with a mobile device or that position coordinates are identified and used to look up a personality identifier. However, Goodisman discloses a method in which a mobile computing device automatically identifies a personality and the location of the device at the time (position coordinates), which is used to find specific document content (document identifier), based on the personality identifier of the device when it is detected, that would be appropriate for the users current location (page 1, paragraphs 0006-0007 and page 2, paragraphs 0025-0026 of Goodisman). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Horowitz and Goodisman because it would have allowed for increased mobility when enriching documents.

**Regarding dependent claim 13**, Horowitz does not disclose a method in which the look up is further refined using a time at which the document or document identifier is selected. However, Goodisman discloses a method in which a time is used to further refine the lookup process (page 2, paragraphs 0025-0026 of Goodisman). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Horowitz and Goodisman because it would have allowed for increased mobility when enriching documents.

**Regarding dependent claim 14**, Horowitz discloses a method in which a personality identifier is associated with identified document content (Figure 8 and column 10, lines 4-45 of Horowitz). An entity in the document content is recognized and a document service is accessed using the recognized entity (column 8, lines 39-61 and column 9, lines 28-63 of Horowitz). The identified document content is then annotated with output from the document service to define enriched content, at which point the content is made available to the users (column 10, lines 4-45 and column 11, lines 39-52 of Horowitz).

**Regarding dependent claims 15-16**, Horowitz does not disclose a method in which a user identifier is also specified in addition to the personality identifier and the document identifier. However, Goodisman discloses a method in which the personality identifier includes and user identifier that is sent along with the document identifier during a request (page 1, paragraphs 0006-0007 and page 2, paragraphs 0025-0026 of Goodisman). It would have been obvious to one of ordinary skill in the art at the time



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the invention was made to have combined the methods of Horowitz and Goodisman because it would have allowed for increased mobility when enriching documents.

**Regarding dependent claims 17-~~19~~<sup>20</sup>**, Horowitz discloses a method in which the enriched content is available to the user (column 9, lines 1-63, column 10, lines 8-27, and column 11, lines 24-52 of Horowitz). Horowitz also discloses that transmitting occurs directly between the reading device (Figure 9 and column 9, lines 1-63, column 10, lines 8-27, and column 11, lines 24-52 of Horowitz). Horowitz also discloses a method in which the document identifier is encoded into the hardcopy of the document as an electronic tag which is recorded by an electronic tag-reading device (column 9, lines 9-63 of Horowitz).

WS  
9/12/05

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horowitz et al. (hereinafter Horowitz, US Patent Number 6,122,647, issued on September 19, 2000) in view of Goodisman et al. (hereinafter Goodisman, US Patent Application Publication Number 2002/0069223, US filing date of November 17, 2000) as applied to claim 1 above, and further in view of Keith JR (hereinafter Keith, US Patent Application Publication Number 2002/0032672, US filing date of March 9, 2000).

**Regarding dependent claim 8**, Horowitz discloses a method in which the document identifier is associated with a personality identifier at the reading device and both identifiers are transmitted to a server (column 9, lines 1-63, column 10, lines 8-27, and column 11, lines 24-52 of Horowitz). Neither Horowitz nor Goodisman explicitly disclose notifying the user when document enrichment is complete. However, Keith

discloses a method in which a user is notified when data of a document has completed an update (Pages 10-11, paragraphs 0092-0094 of Keith). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Horowitz and Goodisman with the methods of Keith because it would have allowed users to see desired information as soon as it was updated with the enriched content.

### ***Response to Arguments***

6. Applicant's arguments filed 7/7/2005 have been fully considered but they are not persuasive.

The arguments on pages 15-17, which are solely in reference to the fact that the applicant alleges that the cited sections in Goodisman do not appear in the provisional application on which Goodisman depends on for proper US filing date are viewed to be unpersuasive. Goodisman discloses a personal identifier defines the personality of a device in provisional application number 60/249,498 (Page 7, "Devices" and Pages 10-12, "Location Services") any one of those properties exist as a personality for the device and are identified to the server when requesting annotated information.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D. Campbell whose telephone number is (571) 272-4133. The examiner can normally be reached on M-F (7:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDC  
September 14, 2005

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9/17/2005